

Docket No: HOPPE-10
Appl. No: 10/789,382

REMARKS

With regard to the requirement for restriction which is the only point raised in the Official Action, Applicant hereby provisionally elects to prosecute Group II, covering claims 10-16 and 19, with traverse, and reserves the right to file a divisional application or to take such other appropriate measures as deemed necessary to protect the invention of Group I.

The Examiner's request for restriction is confusing for the following reasons:

According to the Examiner, Group I (Claims 1-9, 17, 18 and 20) relates to "a method of making electric motor", and Group II (Claims 10-16 and 19) relates to "a motor cooling system". The reasoning set forth by the Examiner for making the restriction requirement reads as follows: *"In the instant case the gas cooled motor can be made parts attached with fasteners, the molding of elements may be used in generators or in motors with heat sinks."*

As stated in Section 806.05(e) of the M.P.E.P, "Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another and materially different process.

Although the wording of the Examiner's reasoning is not understood as it lacks a coherent structure, it is applicant's contention that none of the two conditions (A) and (B) appears to be met. Moreover, Claims 1-9, 17, 18 and 20, on file, are directed to a method of making a **primary part** of an electric motor, and

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thus do not set forth a method of making an electric motor, whereas Claims 10-16 and 19, on file, are directed to the configuration of a **primary part** of an electric motor. Applicant believes that Groups I and II are so closely related to one another that they should remain in the same application. The elected Group II is directed to a primary part, and Group I is concerned with the process of manufacturing such primary part.

In any event, Group II and hence claims 10-16 and 19 are entitled to action on the merits.

Since applicant has fully and completely responded to the Official Action and has made the required election, this application is now in order for early action on the merits of claims 10-16 and 19.

Respectfully submitted,

By: 

Henry M. Feiereisen
Agent for Applicant
Reg. No. 31,084

Date: September 9, 2004
350 Fifth Avenue
Suite 4714
New York, N.Y. 10118
(212) 244-5500
HMF:af